UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
JONES, DAVID

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 April 2000</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-35</u> is/are pending in the application.

　4a) Of the above claim(s) <u>1-5</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>6-35</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) <u>6-35</u> are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>24 April 2000</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

　If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　a)☐ All b)☐ Some * c)☐ None of:

　　1.☐ Certified copies of the priority documents have been received.

　　2.☐ Certified copies of the priority documents have been received in Application No. _____ .

　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
　　　application from the International Bureau (PCT Rule 17.2(a)).
　* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

　a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4,5</u> .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

DETAILED ACTION

Election/Restrictions

1.   Restriction to one of the following inventions is required under 35 U.S.C. 121:

I.   Claims 1-5, drawn to multifunction controller with database manipulation through

a graphical user interface, classified in class 707, subclass 102.

II.   Claims 6-35, drawn to a digital printer with bidirectional data flow across

networks, classified in class 358, subclass 1.15.

The inventions are distinct, each from the other because of the following reasons:

2.   Inventions I and II are related as subcombinations disclosed as usable together in a single

combination. The subcombinations are distinct from each other if they are shown to be

separately usable. In the instant case, invention I has separate utility such as separate utility such

as a multifunction controller with database manipulation through a graphical user interface.

Invention II has separate utility such as a digital printer interface with bidirectional data flow

across networks. See MPEP § 806.05(d).

3.   Because these inventions are distinct for the reasons given above and the search required

for Group I is not required for Group II, restriction for examination purposes as indicated is

proper.

4.   During a telephone conversation with Carlos Munoz-Bustamante on October 7, 2003 a

provisional election was made without traverse to prosecute the invention of Group II, claims 6-

35. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 1-5 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being

drawn to a non-elected invention.

Information Disclosure Statement

5.   The information disclosure statement (IDS) submitted on April 4, 2000. The submission

is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure

statement is being considered by the examiner.

6.   The information disclosure statement (IDS) submitted on September 5, 2000 was filed

after the mailing date of the Application on April 4, 2000. The submission is in compliance with

the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being

considered by the examiner.

Drawings

7.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they

include the following reference sign(s) not mentioned in the description: fig. 2, item140; fig. 3,

items 45A, 45B, ..., 45N; fig. 3, items 30A, 30B, ..., 30N; fig. 3, item 53; all of fig. 5. A

proposed drawing correction, corrected drawings, or amendment to the specification to add the

reference sign(s) in the description, are required in reply to the Office action to avoid

abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

9.   Claims 6-30, 32, 34, and 35 rejected under 35 U.S.C. 102(e) as being anticipated by

Kobayashi et al. U.S. Patent 6,246,487.

Regarding claim 6, Kobayashi et al. discloses an apparatus comprising: an image capture

device, which generates a digital record (fig. 2, #26);

a printer interface (fig. 2, #21) which generates printed copy signals corresponding to the

digital record, the printed copy signals being effective in printing an image derived from the

captured image when coupled to a printer; a controller which couples said image capture device

and said printer interface, said controller having

a first network interface (fig. 9, #500-1) which connects to an area network for

bidirectional exchange of digital data;

and a second network interface (fig. 9, #500-2) which connects to a second network for

bidirectional exchange of digital data;

and a control program (column 8, lines 30-61) stored accessibly to and executable on said

controller, said control program when executing enabling a user to select delivery of the digital

record to a selected one of said printer interface, said first network interface, and said second

network interface.

Regarding claims 7, 11, 15, 19, 23, 27, Kobayashi et al. discloses an apparatus wherein

said control program when executing on said controller enables a user to access a remotely

stored database of address information (column 5, lines 47-64).

Regarding claim 8, 12, 16, 20, 24, 28, Kobayashi et al. discloses an apparatus further

comprising: a memory coupled to and housed with said controller (column 6, lines 24-39); said

control program when executing on said controller further enabling a user to store a database of

address information in said memory and enabling access to said database of address information

stored in said memory (column 12, lines 17-38).

Regarding claims 9, 13, 17, 21, 25, 29, Kobayashi et al. discloses an apparatus further

comprising a memory coupled to and housed with said controller (column 6, lines 24-39); said

control program when executing on said controller further enabling a user to store a database of

address information (column 5, lines 47-64) in said memory and to selectively access one of said

database of address information stored in said memory and a second database of address

information stored remotely from said controller and accessible through said first network

interface, fig. 1 shows that there is a LAN (#500) connection between the server and the

multifunction device.

Regarding claim 10, Kobayashi et al. discloses an apparatus comprising: an image

capture device which generates a digital record (fig. 2, #26); a printer interface which generates

printed copy signals corresponding to the digital record, the printed copy signals being effective

in printing an image derived from the captured image when coupled to a printer (fig. 2, #21); a

controller which couples said image capture device and said printer interface (fig. 2, #27), said

controller having a first network interface (fig. 9, #500-1) which connects to an area network for

bidirectional exchange of digital data; and a second network interface (fig. 9, #500-2) which

connects to a second network for bidirectional exchange of digital data; and a control program

stored accessibly to and executable on said controller, said control program when executing

enabling a user to select delivery of the digital record to any selected two of said printer interface

(fig. 12, #251 & #252), said first network interface, and said second network interface.

Regarding claim 14, Kobayashi et al. discloses an apparatus comprising: an image

capture device, which generates a digital record (fig. 2, #26); a printer interface (fig. 2, #21)

which generates printed copy signals corresponding to the digital record, the printed copy signals

being effective in printing an image derived from the captured image when coupled to a printer;

a controller (fig. 2, #27) which couples said image capture device and said printer interface, said

controller having a first network interface (fig. 9, #500-1) which connects to an area network for

bidirectional exchange of digital data; and a second network interface (fig. 9, #500-2) which

connects to a second network for bidirectional exchange of digital data; and a control program

stored accessibly to and executable on said controller, said control program when executing

enabling a user to select delivery of the digital record to each and all of said printer interface,

said first network interface, and said second network interface. From fig. 15, step S12 acquires a

routing list and at step S13 allows the user to select the destination printers from the list (column

15, lines 58-65).

Regarding claim 18, Kobayashi et al. discloses an apparatus comprising: an image

capture device which generates a digital record (fig. 2, #26); a printer which generates a printed

copy derived from the digital record (fig. 2, #21); a controller (fig. 2, #27) which couples said

image capture device and said printer, said controller having a first network interface (fig. 9,

#500-1) which connects to an area network for bidirectional exchange of digital data; and a

second network interface (fig. 2, #500-2) which connects to a second network for exchange of

digital data; and a control program stored accessibly to and executable on said controller, said

control program when executing enabling a user to select delivery of the digital record to a

selected one of said printer (column 8, lines 30-61), said first network interface, and said second

network interface.

Regarding claim 22, Kobayashi et al. discloses an apparatus comprising: an image

capture device which generates a digital record (fig. 2, #26); a printer which generates a printed

copy derived from the digital record (fig. 2, #21); a controller (fig. 2, #27) which couples said

image capture device and said printer, said controller having a first network interface (fig. 9,

#500-1) which connects to an area network for bidirectional exchange of digital data; and a

second network interface (fig. 9, #500-2) which connects to a second network for exchange of

digital data; and a control program stored accessibly to and executable on said controller, said

control program when executing enabling a user to select delivery of the digital record to any

selected two of said printer(fig. 12, #251 & #252), said first network interface, and said second

network interface.

Regarding claim 26, Kobayashi et al. discloses an apparatus comprising: an image

capture device which generates a digital record (fig. 2, #26); a printer which generates a printed

copy derived from the digital record (fig. 2, #21); a controller (fig. 2, #27) which couples said

image capture device and said printer, said controller having a first network interface (fig. 9,

#500-1) which connects to an area network for bidirectional exchange of digital data; and a

second network interface which connects to a second network (fig. 9, #500-2) for exchange of

digital data; and a control program stored accessibly to and executable on said controller, said

control program when executing enabling a user to select delivery of the digital record to each

and all of said printer, said first network interface, and said second network interface. From fig.

15, step S12 acquires a routing list and at step S13 allows the user to select the destination

printers from the list (column 15, lines 58-65).

Regarding claim 30, Kobayashi et al. discloses a method comprising the steps of:

capturing a digital record of a document (column 6, lines 50-60); executing on a controller a

control program which enables a user to select delivery of the captured digital record to one of an

associated printer, a first network interface, and a second network interface (column 13, lines 24-

47); and performing in accordance to such selection one of:

1. delivering the digital record to the printer to generate a copy of the

document (fig. 15, #S14);

2. delivering the digital record to the first network interface to generate an

electronic mail message (fig. 15, #S14; column 20, lines 24-25);

3. delivering the digital record to the second network interface to generate a

facsimile transmission to a remote facsimile receiver (column 5, lines 59-64).

Regarding claim 32, Kobayashi et al. discloses a method comprising the steps of:

capturing a digital record of a document (column 6, lines 50-60); executing on a controller a

control program which enables a user to select delivery of the captured digital record to at least

two of an associated printer, a first network interface, and a second network interface (column

13, lines 24-47); and performing in accordance to such selection at least two of:

1. delivering the digital record to the printer to generate a copy of the document (fig. 15,

#S14);

2. delivering the digital record to the first network interface to generate an

electronic mail message (fig. 15, #S14; column 20, lines 24-25);

3. delivering the digital record to the second network interface to generate a

facsimile transmission to a remote facsimile receiver (column 5, lines 59-64).

Regarding claim 34, Kobayashi et al. discloses a program product comprising: a

computer (column 5, lines 23-35) and it would be inherent that the computer contain a computer

readable medium; a control program (column 8, lines 30-61) stored on said medium, said control

program when executing on a controller which couples an image capture device, a printer, and

first and second network interfaces, enabling a user to select delivery of a digital record captured

by the device to one of the printer, the first network interface (fig. 9, #500-1), and the second

network (fig. 9, #500-2) interface by performing in accordance to such selection one of:

(a) delivering the digital record to the printer to generate a copy of the document (fig. 15,

#S14);

(b) delivering the digital record to the first network interface to generate an electronic

mail message (fig. 15, #S14; column 20, lines 24-25);

(c) delivering the digital record to the second network interface to generate a facsimile

transmission to a remote facsimile receiver (column 5, lines 59-64).

Regarding claim 35, Kobayashi et al. discloses a program product comprising: a

computer readable medium; a control program stored on said medium, said control program

when executing on a controller which couples an image capture device, a printer, and first and

second network interfaces, enabling a user to select delivery of a digital record captured by the

device to at least two of the printer, the first network interface, and the second network interface

(column 19, lines 33-51) by performing in accordance to such selection at least two of:

(a) delivering the digital record to the printer to generate a copy of the document (fig. 15,

#S14);

(b) delivering the digital record to the first network interface to generate an

electronic mail message (fig. 15, #S14; column 20, lines 24-25);

(c) delivering the digital record to the second network interface to generate a facsimile

transmission to a remote facsimile receiver (column 5, lines 59-64).

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

11.   Claims 31 and 33 rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi

et al. as applied to claims 6-30, 32, 34, and 35 above, and further in view of Brossman et al. U.S.

Patent 6,266,150.

Regarding claims 31 and 33, Kobayashi et al. discloses a process whereby a print

notification is sent by email (column 20, lines 24-25), Kobayashi et al. does not explicitly

disclose that the document itself is to be sent as a text and PDF document within the email

document. Whereas, Brossman et al. discloses (column 11, lines 44-67; column 12, lines 1-20)

that there is a wrapper email function that will wrap a bitmap image in a page description

language (PDL) such as PDF, and that if the data stream is already in a native format recognized

by the target presentation device processing continues to the output device i.e. email text

document. Therefore, it would have been obvious at the time the invention was made to include

in the Kobayashi et al. application the ability to include the document in the email notification as

a text and PDF, whereby allowing ease of access to the document use and to be designated at

step S14 in fig. 15.

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Maniwa et al. U.S. Patent 5,768,483 discloses a server machine queues print jobs time-sequentially, NIC takes out the print jobs on the server machine job by each job and transfers each print job to a printer controller, the printer controller executes each of the print jobs, the printer controller generates an appropriate message according to whether a print job has been completed or interrupted, NIC transfers a message to the server machine, the server machine transfers the message to the corresponding client machine, and the client machine automatically displays contents of the message. Hu et al. U.S. Patent 5,361,134 discloses a multifunctional document processing system for faxing, copying, printing or scanning document information and for transmitting and receiving document signals to and from a remote device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L Jones whose telephone number is (703) 305-4675. The examiner can normally be reached on Monday - Friday (7:00am - 3:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

dlj

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